

US Serial No. 10/554344

Page 4 of 10

Remarks:

*Amendments to the claims:*

Claims 1-11 are pending in this application. By this Amendment, claims 1 and 2 are amended.

No new matter is added to the application by this amendment. The features added to claims 1 and 2 find support in Figs. 1-3, as originally filed, and within the specification, as originally filed, at, for example, paragraphs [0019] and [0021] of U.S. Patent Publication No. 2006/0249593 (hereinafter "the '593 publication") for the present application

Entry of the amendments is proper under 37 CFR §1.116 since the amendments:

(a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments and reconsideration of the application are thus respectfully requested.

*Regarding the rejection of claims 1-3 and 9 under 35 USC 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2003/0005620 to Ananth et al. (hereinafter "Ananth"):*

Applicants respectfully traverse the rejection of the foregoing claims in view of Ananth.

Prior to discussing the relative merits of the Examiner's rejection, Applicants point out that unpatentability based on "anticipation" type rejection under 35 USC 102 requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee").

US Serial No. 10/554344

Page 5 of 10

Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus, when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

US Serial No. 10/554344

Page 6 of 10

The Patent Office alleges that Ananth teaches each and every feature recited in claims 1-3 and 9. Applicants respectfully disagree with the allegations by the Patent Office.

Nowhere does Ananth teach or suggest a cover portion including a housing element adapted to engage within the shaped recess when the dispensing device is assembled as required by independent claims 1 and 2.

The present invention relates to a dispensing device comprising a refill and a cover portion including a housing element, i.e., an element which contributes to the housing. With the present invention, when the refill and the cover portion are assembled to form the dispensing device, the housing element of the cover portion is engaged within the shaped recess in the upper portion of the wick via the housing element adapted to engage the shaped recess when the dispensing device is assembled as specifically defined in claims 1 and 2 (see the Abstract and paragraphs [0018], [0019] and [0021] of '593 publication). Thus, the features of claims 1 and 2 avoid the problem of using inappropriately-dimensioned refills with the presently claimed dispensing device.

In contrast, Ananth discloses a sleeve which merely covers the wick. The cavity in the wick of Ananth helps provide a burst of vapor that is ready when the device is first heated (see paragraph [0016] of Ananth). Moreover, Ananth teaches that the cavity (and the walls adjacent thereto) collect liquid from the container through the wick by means of capillary action, forming a pool of liquid in the cavity (see paragraph [0046] of Ananth). At best, Ananth teaches that the wick is preferably covered with a metal sleeve, plastic film, or paint (see paragraph [0046] of Ananth).

In no way does a metal sleeve that merely covers the wick of Ananth disclose a metal sleeve that engages within the recess of Ananth. Contrary to the Patent Office's allegations, the metal sleeve of Ananth does not engage within the cavity in the system of Ananth as recited in claims 1 and 2.

In view of the teachings of Ananth, Ananth clearly fails to disclose a cover portion including a housing element adapted to engage within the shaped recess when the

US Serial No. 10/554344  
Page 7 of 10

dispensing device is assembled as recited in present claims 1 and 2 of the present application.

Because the features of independent claims 1 and 2 are not disclosed by Ananth, Ananth cannot anticipate, nor would not have rendered obvious, the features specifically defined in claims 1 and 2 and their dependent claims.

For at least these reasons, claims 1-3 and 9 are patentably distinct from and/or non-obvious in view of Ananth. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. 102(e) are respectfully requested.

*Regarding the rejection of claims 4-8 and 10 under 35 USC 103(a) as being unpatentable over Ananth:*

Applicants respectfully traverse the rejection of the foregoing claims in view of Ananth.

The Patent Office alleges that one of ordinary skill in the art would have readily recognized that modifying the teachings of Ananth would achieve the features recited in claims 4-8 and 10. Applicants disagree with these allegations by the Patent Office.

Even if one of ordinary skill in the art would have modified the teachings of Ananth as alleged by the Patent Office, such resulting modifications of Ananth would not achieve the present invention defined in independent claim 1, from which claims 4-8 and 10 depend because the resulting modifications of Ananth would not have a cover portion having a housing element adapted to engage within the shaped recess in the upper portion of the porous wick.

As set forth above with respect to claim 1, Ananth fails to teach or suggest a cover portion including a housing element adapted to engage within the shaped recess in the upper portion of the porous wick when the dispensing device is assembled as required by claim 1.

US Serial No. 10/554344

Page 8 of 10

Because the features of independent claim 1 are not taught or suggested by Ananth, Ananth would not have rendered the features of claims 4-8 and 10, which depend from claim 1, obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

*Regarding the rejection of claim 11 under 35 USC 103(a) as being unpatentable over Ananth in view of U.S. Patent No. 6,361,752 to Demarest et al. (hereinafter "Demarest")):*

Applicants respectfully traverse the rejection of the foregoing claim in view of Ananth and Demarest.

The Patent Office acknowledges that Ananth does not teach or suggest using a fan (see page 6 of the Office Action). The Patent Office introduces Demarest as allegedly remedying the deficiencies of Ananth by allegedly teaching a fan that dispenses volatile material from a reservoir through a wick in order to move air across the material and blow the resultant vapor into the surrounding environment (see the last paragraph on page 6 of the Office Action). Applicants respectfully disagree with these allegations.

Demarest fails to remedy the deficiencies of Ananth as set forth above with respect to claim 1, from which claim 11 depends because Demarest fails to teach or suggest a cover portion having a housing element adapted to engage within a shaped recess. At best, Demarest discloses that if a liquid volatile material or carrier substance is to be heated by the coil to vaporize the volatile material, the apparatus includes a wick that is in contact with the liquid and extends to the vicinity of the coil to transport the liquid to the coil for heating (see col. 2, lines 45-54 of Demarest).

Thus, Ananth and Demarest, taken singly or in combination, do not teach or suggest a cover portion having a housing element adapted to engage within the shaped recess in the

US Serial No. 10/554344

Page 9 of 10

upper portion of the porous wick when the dispensing device is assembled as recited in claim 1, from which claim 11 depends.

Because the features of independent claims 1 are not taught or suggested by Ananth and Demarest, taken singly or in combination, these references would not have rendered the features of claim 11 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

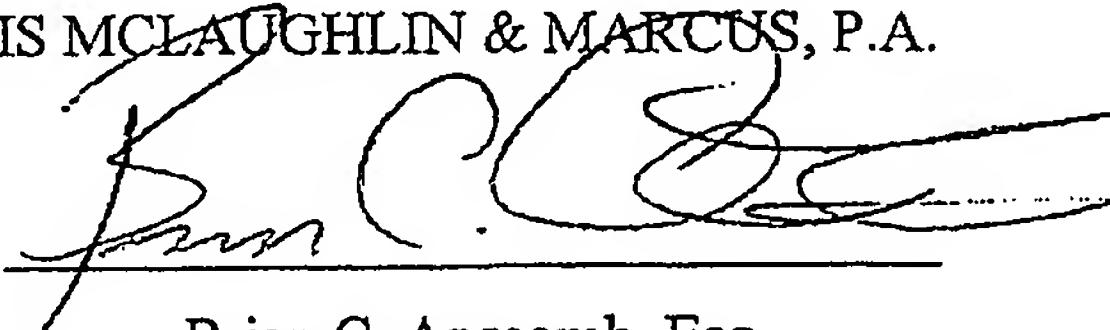
#### **CONDITIONAL AUTHORIZATION FOR FEES**

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MC LAUGHLIN & MARCUS, P.A.

By

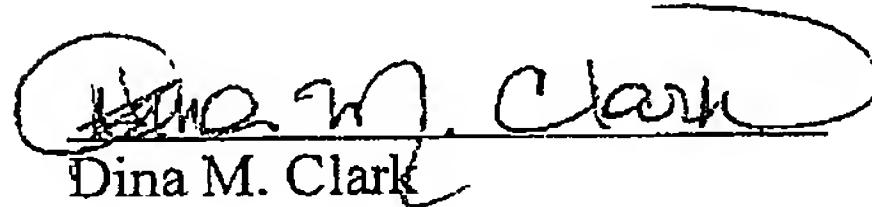


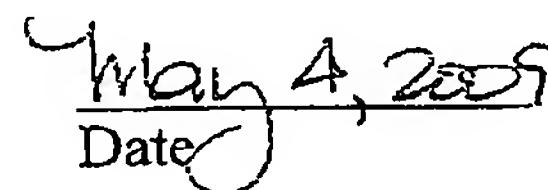
Brian C. Anscomb, Esq.  
Attorney for Applicants  
Reg. No. 32,431  
875 Third Avenue, 18<sup>th</sup> Floor  
New York, NY 10022  
Tel. 212-808-0700

US Serial No. 10/554344  
Page 10 of 10

CERTIFICATE OF TELEFAX TRANSMISSION UNDER 37 CFR 1.8

I certify that this document, and any attachments thereto, addressed to the:  
“Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450” is being  
telefax transmitted to (571) 273-8300 at the United States Patent and Trademark Office.

  
Dina M. Clark

  
Date